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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|----------------------|------------------|
| 10/578,497 | 04/02/2007 | Reiner Fischer | 2400.0300000/VLC/CMB | 1712 |

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1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

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| EXAMINER |
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CHU, YONG LIANG

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| ART UNIT | PAPER NUMBER |
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1626

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| MAIL DATE | DELIVERY MODE |
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01/26/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/578,497 | Applicant(s) FISCHER ET AL. | |
| | Examiner YONG CHU | Art Unit 1626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-6,8,9 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) 6,9 and 11-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5,8 and 11-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/23/2009 has been entered. Upon entering the submission, claims 3-6, 8-9, and 11-15 are pending in the instant application, claims 6, 9, and 11-15 remain withdrawn, and claims 3-5, 8 and 11-15 are under examination on the merits.

Declaration under Rule 37 C.F.R. §1.132

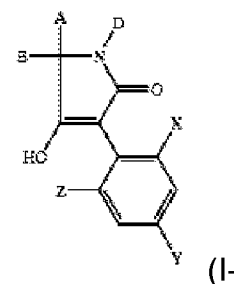
Applicants' submission of the Declaration under Rule 37 C.F.R. §1.132, filed on 12/23/2009 has been entered.

Response to RCE Submission

Claim rejection under 35 U.S.C. §103(a)

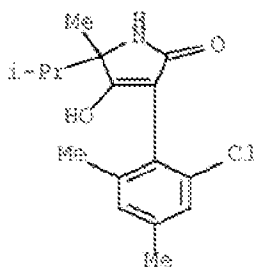
Applicants argument on the ground that the Office has failed to provide a rational as to why a person of ordinary skilled in the art would replace methyl with any other C2-C6-alkyl at the **Z** position has been full considered, but is found not persuasive. The previously cited US 6,469,196 ("the '196 patent") teaches pesticides and/or herbicides

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sharing the same core structure of the instantly claimed compounds as

1-a) wherein **D** is -H; **A** and **B** as alkyl; or **A** and **D** together forms the groups AD-1 to

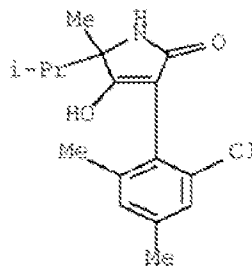


AD-27 with the specific compound

, see page 6 of the previous Office

action on 03/03/2009. The only difference between the `196 compound and the instantly claimed compounds is at **Z** as a methyl group vs. an ethyl group, and they are homolog. The motivation for modifying the prior art teaching to the instant application was articulated at page 7 of the Office action on 03/03/2009.

In addition, the 132 Declaration filed on 12/23/2009 by Dr. Heinz Kehne is also not sufficient to overcome the rejection for the following reasons: 1) the Declaration did not declare who created the testing data and how the data related to the instant application; 2) the compounds tested in the Declaration are the compounds wherein **X** is -Br, not -Cl as cited in the `196 compound, and no unexpected results has been

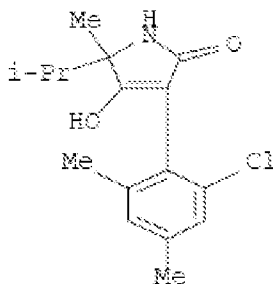


demonstrated over the cited prior art compound ; 3) In addition, the data did not demonstrated unexpected results, instead an expected results of the compounds used as pesticides and/or herbicides. Since a product is inseparable from its properties, it is an objective reach of a claim from prior art teachings, even though the compounds are used for treating different microorganism species. The motivation is that compounds having similar chemical structure assume the similar biological properties. Therefore, the rejection is maintained.

Obvious-type Double Patenting Rejection

Applicants' argument on the ground that the claims of the '274 patent disclose thousand of compounds, and the Office has not provided a reason why a person of ordinary skilled in the art would choose a compound wherein **X** is chlorine or bromine, **Y** is methyl or ethyl and **Z** is ethyl or n-propyl as a lead compound from among the thousands of compounds recited by the '274 patent has been fully considered, but not persuasive. The claimed scope between the instant claims 3-5 and 8 and claims 1-4, 6 and 8 of the '274 patent are overlapped with the same core structure, and the

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compound (CAS RN 186746-85-0)

disclosed in the '274 patent is a

homolog, which reads on the instant claims, wherein **Z** is -CH₃, and renders the instant claims obvious (i.e. **Z** is -CH₃ vs. -CH₂CH₃). See Page 8 of the previous Office action, and the analysis under 103(a) above. Therefore, the ODP rejection is maintained.

Conclusion

Claims 3-5, 8 and 11-15 are rejected.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu, Ph.D., whose telephone number is 571-272-5759. The examiner can normally be reached between 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Status Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Yong Chu/
Primary Patent Examiner
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